

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on November 28, 2003, the Examiner indicated that the rejections to the claims under 35 U.S.C. §112 and the objection to the specification and were withdrawn. However, the Examiner rejected claims 21-29, 31-38, and 40-41 under 35 U.S.C. §103(a) as being unpatentable over Evans (U.S. Patent No. 5,924,074, hereinafter “Evans”) in view of Feldon et al (U.S. Patent No. 5,732,221, hereinafter “Feldon”). Applicant expresses appreciation for the Examiner’s Interview and respectfully provides the following:

In the Office Action, the Examiner rejected claims 21-29, 31-38, and 40-41 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Feldon. Evans discloses a medical records system that creates and maintains all patient data electronically. The system captures patient data, such as patient complaints, lab orders, medications, diagnoses, and procedures, at its source at the time of entry using a graphical user interface having touch screens. Using pen-based portable computers with wireless connections to a computer network, authorized healthcare providers can access, analyze, update and electronically annotate patient data even while other providers are using the same patient record. The system likewise permits instant, sophisticated analysis of patient data to identify relationships among the data considered. Moreover, the system includes the capability to access reference databases for consultation regarding allergies, medication interactions and practice guidelines. The system also includes the capability to incorporate legacy data, such as paper files and mainframe data, for a patient.

(Abstract)

Feldon teaches a system and method for generating written reports based on succinct input from a user. A method comprises entering a first mode for initialization; defining menus;

entering a second mode for receiving information; entering information using the defined menus; interpreting the entered information; and generating a written report in response to the interpreting step. A system comprises a portable computer system having a memory, a processor, a detachable keyboard, a screen, and a pen. Ancillary information is entered with the keyboard which is then detached. Subsequent information is documented by selecting appropriate items from the defined menus; alternatively, the information can be written on the screen with the pen. The processor is programmed to interpret the inputs and generate a report. The report may be printed on a printer, stored on a storage device, and/or transferred to another system. (Abstract)

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the combination of Evans and Feldon does not satisfy a *prima facie* case of obviousness of the claim set as provided herein since neither reference nor a combination of the references teaches or suggests all the claim limitations.

Independent claims 21 and 33 includes limitations of electronically selecting a pool of healthcare procedures characteristically performed by a particular healthcare provider of a healthcare facility for inclusion in a customizable form, wherein the pool of healthcare procedures reflect the medical services rendered by the particular healthcare provider; electronically selecting one or more healthcare diagnoses characteristically employed by the

particular healthcare provider for inclusion in the customizable form, wherein the one or more diagnoses are reasons for performing at least one of the procedures from the pool of healthcare procedures characteristically performed by the particular healthcare provider; generating the customizable form for use in association with the healthcare provider rendering one of the procedures from the pool of healthcare procedures on a patient, wherein the step for generating the customizable form comprises selectively defining display specifications that relate to at least one of (i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preferences; and using the customizable form in association with rendering one of the procedures from the pool of healthcare procedures by selecting at least one of: (i) a diagnosis of the customizable form; and (ii) a procedure of the customizable form.

Applicant respectfully submits that the combination of Evans and Feldon does not satisfy a prima facie case of obviousness of the claim set as provided herein for at least the reason that neither reference, nor a combination of the references, teaches or suggests the limitations claimed of generating the customizable form for use in association with the healthcare provider rendering one of the procedures from the pool of healthcare procedures on a patient, wherein the step for generating the customizable form comprises selectively defining display specifications that relate to at least one of (i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preferences.

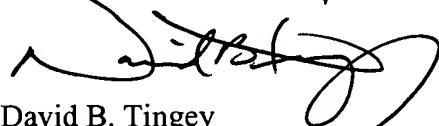
Accordingly, since the references do not teach each and every limitation of independent claims 21 and 33, Applicant respectfully submits that neither claim 21 nor claim 33 is made obvious by the references cited by the Examiner. Similarly, since claims 22-29 and 31-32 depend from independent claim 21 and claims 34-38 and 40-41 depend from claim 33, Applicant respectfully submits that claims 22-29, 31-32, 34-38, and 40-41 are also not made obvious by the references cited by the Examiner for at least the reasons provided above.

CONCLUSION

Applicant respectfully submits that the claim set provided herein does not add new matter and is now in condition for allowance. Accordingly, Applicants therefore request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

Dated this 29th day of March, 2004.

Respectfully submitted,



David B. Tingey
Attorney for Applicant
Registration No. 52,289

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 323-5986
Facsimile: (801) 321-4893